

RECEIVED
CENTRAL FAX CENTER**APR 06 2006**

VIA FACSIMILE, No. 571-273-8300 (12 pages)

Date of Deposit: April 6, 2006

Attorney Docket No.: 101769-120 tesa AG 1510-WCG

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Achim FRANCK, et al.
Serial No. : 10/014,484
Filed : December 11, 2001
For : REDETACHABLE DEVICE
Art Unit : 1771
Examiner : Daniel R. Zirker

April 6, 2006

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' BRIEF ON APPEAL PURSUANT TO 37 CFR § 41.37

Sir:

This is an appeal from the final rejection of an Examiner of Art Unit 1771.

1. REAL PARTY IN INTEREST

The instant application is owned by tesa AG, record owner hereof.

2. RELATED APPEALS AND INTERFERENCES

The undersigned is not aware of any appeals, interferences, reexaminations,

04/07/2006 MBINAS 00000034 141263 10014484

01 FC:1402 500.00 DA

infringement actions or the like in any related applications.

3. STATUS OF CLAIMS

The claims pending in this application are claims 1, 5, 7-8, 10-13 and 18, and all of said claims are on appeal.

4. STATUS OF AMENDMENTS

The last amendment was that filed on January 9, 2006 (by facsimile) and that amendment was entered. There are no outstanding amendments.

5. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1 relates to a novel redetachable self-adhesive device (page 1, first paragraph) in the form of a structure (page 5, first full paragraph), having a surface bonded to a double-sided adhesive strip (first sentence of first full paragraph on page 5). The adhesive strip is of a known kind that can be redetached by stretching (page 6, 4th line of 4th full paragraph). The end(s) of the adhesive strip is provided with a non-adhesive region (i.e., a "grip tab") (page 1, first and second paragraphs; and sentence bridging pages 7 and 8). The area of the surface which is adjacent to the grip tabs of the adhesive strip is roughened (page 5, first sentence of paragraph bridging pages 5 and 6; page 7, first full paragraph, and designating lines 3(A) and 3(B) of Figures 1 and 2).

Surprisingly, the roughened areas enable a markedly reduced tendency of the adhesive strips to tear during the process of stretching the adhesive strips to debond the devices the from substrates to which they have been bonded ("Result:" table, middle of page 9).

6. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

The grounds for rejection to be reviewed on appeal are the rejection of claims 1, 5, 7-8, 10-13 and 18 under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Lühmann et al 6,136,397 (=EP 0832588).

7. ARGUMENTS

Initially, it should be noted that the Lühmann reference, which is briefly discussed in the paragraph bridging pages 2 and 3 and at page 6, 4th full paragraph, of Appellants' specification, is concerned with debonding a device from a substrate to which it is attached, by pulling/stretching the adhesive strip at an approximately right angle. The technology disclosed in the Lühmann reference addresses those situations where, due to spatial limits, pulling in the bond plane is not possible (Lühmann '397, col. 2, lines 32-36). To do this, Lühmann treats the ends of his devices, adjacent to the grip tabs of the adhesive strip, to make them low-stick (i.e., by coating them with low surface energy materials, such as fluorinated polymers)(col. 2, lines 53-55; col. 3, lines 11-15)

The Examiner refers specifically to column 5, lines 29-34 of Lühmann et al 6,136,397 as teaching how to adjust the frictional coefficients so as to obtain the desired frictional characteristics. The Examiner equates the "frictional" characteristics to "roughness", but the reference does not teach this – this is the Examiner's own conclusion. In this regard It should be noted that for the present application, "average roughness" has a specific technical meaning, as defined by DIN 4768 (page 9, 4th line of text from the bottom).

Moreover, column 5, lines 29 et seq of the '397 reference specifically teaches that the frictional force can be reduced by such steps as forming the edge region of a low energy plastic; such as poly(tetrafluoroethylene), high density polyethylene etc., having surface tensions \leq about 37 mN/m.

This has nothing to do with introducing a surface roughness, as defined by DIN 4768, and such as would be achieved by etching, grinding, embossing, etc. (Appellants' specification,' page 6, line 15). In fact, those skilled in the art would think of low-energy surfaces as being smooth surfaces, such as Teflon[®] coated surfaces.

The Lühmann '397 reference discloses the use of plates which, on the grip side, in the edge region of the adhesive bond, contain a material *which has a lowest possible coefficient of stick friction and a low coefficient of slip friction with respect to the adhesive film* (col. 4, lines 12-14).

Appellants have previously provided the Examiner with a copy of an 8-page paper found over the internet, entitled "Resistive Force of Friction". Appellants specifically drew the Examiner's attention to the language found at about the middle of the first page of this article, where a statement can be found that "Friction is caused by the roughness of the materials rubbing against each other..."

It is therefore clear that to obtain the low degrees of friction called for by Lühmann,

one would turn to a smooth surface; not a rough surface.

Appellants, however, take the exactly opposite direction in their claims....Appellants require a roughened surface and, in their specification, show that this can be obtained e.g. by etching, grinding, embossing or spark erosion (page 6, 3rd full paragraph of text).

The very paragraph that the Examiner refers to in Lühmann et al 6,136,397 is specifically directed towards reducing frictional force (col. 5, line 34) using e.g. low-energy plastic. All persons skilled in the art would see this as the antithesis of induced roughness, such as is required in Appellants' claims.

Those skilled in the art reading about Lühmann's use of low-energy surfaces, such as poly(tetrafluoroethylene) [col. 5, line 39] would certainly not be led to the use of a roughened surface, particularly in view of Lühmann's requirement for low friction whereas those skilled in the art understand that roughening a surface would increase its friction.

Clearly, the teachings of Lühmann '397 are in the opposite direction of Appellants' claims, and Lühmann '397 cannot possibly be seen as teaching devices having roughened surfaces, as claimed by Appellants.

In addition, since Lühmann '397 teaches in the opposite direction of Appellants' claims, Lühmann '397 cannot fairly be seen as in any way suggesting the changes that would be necessary to arrive at Appellants' device.

Furthermore, Appellants claims are directed to a specific range of average roughness R_a , i.e., 2-20 μm .

Nothing in the '397 reference teaches or suggests anything at all about the desirability of a specific degree of surface roughness R_a , or indeed, even recognizes the concept of average roughness R_a .

The Examiner contends that Appellants' range of roughness based parameters "inherently read upon a significant number of the embodiments disclosed by the reference, even though a significant number of the reference's embodiments deal with 'low stick and slip friction'.

The Examiner has not pointed to one single embodiment of the Lühmann reference which he believes Appellants' claims "inherently read upon". To the contrary, those skilled in the art reading Lühmann will see that this reference is specifically directed to edge regions having 'low stick and slip friction'. Where does the Examiner see any embodiments that do not have 'low stick and slip friction'?

In addition, the Examiner's contention of inherency is completely without basis, and amounts to sheer unsupported speculation. For inherency to exist as to any particular element, the extrinsic evidence must make clear that such element is *necessarily* present in the thing described in the reference, and the presence of such element therein would be

so recognized by persons skilled in the art. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further, inherency is not established by probabilities or possibilities, and the mere fact that a property may result from a given circumstances is not sufficient; instead it must be shown that such property *necessarily* inheres in the thing described in the reference. Nowhere does Lühmann '397 teach or suggest anything at all about surface roughness. In addition, the Examiner has provided absolutely no evidence whatsoever that would in any way suggest that the edge regions of Lühmann have surface roughness that would even begin to approach those of Appellants' claims. Consequently, Lühmann '397 cannot be seen as "inherently" anticipating or suggesting the present claims.

The '397 reference therefore cannot fairly be seen as teaching or suggesting Appellants' device.

The rejection of claims 1, 5, 7-8, 10-13 and 18 under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Lühmann et al '397 should accordingly be REVERSED.

8. CONCLUSION

Wherefore it is submitted that the final rejection is in error and should be REVERSED.

AUTHORIZATION TO CHARGE FILING FEE TO DEPOSIT ACCOUNT

Appellant is:

☐ a small entity

☒ other than a small entity

It is requested that the fee for the filing of the Brief on Appeal be charged to the undersigned's Deposit Account No. 14-1263.

Please charge:

☐ \$ 250.00 for small entity

☒ \$500.00 for other than small entity.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, appellants request that this be considered a petition therefor. Please charge the required Petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By 

William C. Gerstenzang

Reg. No. 27,552

WCG/tmo

875 Third Avenue, 18th Floor
New York, New York 10022
(212) 808-0700

I hereby certify that this correspondence is being transmitted via facsimile, no. 571-273-8300 to the United States Patent and Trademark Office, addressed to: Mail Stop Appeal Brief Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 6, 2006.

By 
Zsuzsa Schuster

Date April 6, 2006

9. CLAIMS APPENDIX

The claims on appeal read as follows:

Claim 1. A redetachable self-adhesive device, in the form of a structure

a) comprising a surface which is bonded to one side of a double-sided adhesive strip with at least one end of the adhesive strip projecting beyond at least one edge of said surface as a grip tab,

b) the adhesive strip being redetachable by pulling on the grip tab of the strip to stretch the strip in the direction of a plane formed between the strip and the surface it is bonded to,

wherein

c) said surface, in the area immediately adjacent to said at least one end of the adhesive strip projecting as a grip tab, has an average roughness R_a of 2-20 μm and has an average depth of roughness R_z of 2-100 μm .

Claim 5. The device as claimed in claim 1, wherein the area of the surface having the average roughness R_a is produced together with the device by injection molding, or wherein the method of production of said area is selected from the group consisting of etching, grinding, embossing or spark erosion.

Claim 7. The device as claimed in claim 1, wherein said surface has two opposite edges wherein the areas of said surface immediately adjacent to said two opposite edges of said surface have said average roughness R_a .

Claim 8. The device as claimed in claim 1, further comprising spacers on the surface of the device to which the adhesive strip is bonded wherein the heights of said spacers are less than the thickness of the adhesive strip.

Claim 10. The device as claimed in claim 1, wherein the double-sided adhesive strip is elastically or plastically extensible with or without a carrier in between the two sides of said double-sided adhesive strip.

Claim 11. The device as claimed in claim 1, wherein the adhesion of the double-sided adhesive strip is less than the cohesion, the adhesion largely disappears when the strip is extended, and the ratio of peel force to tear load is at least 1:2.0, the double-sided adhesive strip being based on thermoplastic rubber and tackifying resins.

Claim 12. The device as claimed in claim 1, wherein the side of the double-sided adhesive strip opposite the side that is bonded to the surface of the device is lined with a release laminate or a release film.

Claim 13. The device as claimed in claim 1, wherein said device comprises a hook or latching projection.

Claim 18. The device of Claim 12, wherein said release laminate or release film is a siliconized release paper.

10. EVIDENCE APPENDIX

Paper entitled: "Resistive Force of Friction", annexed to Rule 111 Amendment filed May 12, 2005.

11. RELATED PROCEEDINGS APPENDIX

There have been no decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of 37 CFR 41.37